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In re Application of
YI et al.
Application No.: 10/525,241
PCT No.: PCT/US03/26356
Int. Filing Date: 22 August 2003
Priority Date: 23 August 2002
Attorney Docket No.: 7512.145
For: ASSEMBLY OF CHITOSAN ONTO AN
ELECTRODE SURFACE

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: DECISION ON
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: DECLARATION
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This is a decision on applicants' "Response to Notification of Defective Response", filed on 16 May 2006 in the United States Patent and Trademark Office (USPTO), requesting acceptance of the declaration in the above reference application. Applicant also submitted a copy of the "Request to Correct Inventorship under Rule 92bis" filed in the corresponding PCT application on 22 February 2005.

BACKGROUND

On 22 February 2005, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee. On the same day, applicant also filed a "Request to Correct Inventorship under Rule 92bis" in the corresponding PCT application.

On 19 August 2005, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration, in compliance with 37 CFR 1.497(a) and (b), was required. The Notification set a two month time limit within which to respond. Extensions of time were available under 37 CFR 1.136(a).

On 17 March 2005, applicant filed a declaration, identifying the international application and listed Li-Qun Wu and Mark J. Kastantin, among those listed in the published international application, as inventors. Applicant did not provide Form PCT/IB/306 adding Li-Qun Wu and Mark J. Kastantin as co-inventors.

On 19 April 2006, a Notification of Defective Response was mailed to applicant indicating that the declaration was unacceptable because (1) it was not executed in accord with 37 CFR 1.66 or 1.68 and (2) inventors Li-Qun Wu and Mark J. Kastantin were not listed on the published application. Applicant was advised to provide information regarding how the inventors were added to the international application, that is, Form PCT/IB/306. The Notification advised applicant that he must provide a complete response within the time limit of ONE month from the date of the Notification (or by 19 May 2006) or within the time remaining in the response set forth in the Notification of Missing Requirements (19 March 2006), whichever was longer. Applicant was also advised that "no extension of this time limit may be granted under 37 CFR

1.136 but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).”

On 19 May 2006, applicant filed the instant response along with a copy of the Request for Recording of A Change to add Li-Qun Wu and Mark J. Kastantin as co-inventors under PCT Rule 92*bis*.

DISCUSSION

A review of international application PCT/US03/26356 reveals that Li-Qun Wu and Mark J. Kastantin were not named as inventors in the published international application. On 22 February 2005, applicant requested the Recording of A Change to add Li-Qun Wu and Mark J. Kastantin as co-inventors under PCT Rule 92*bis* in PCT/US03/26356. However, a review of the international application filed indicates that on 02 June 2006, a Communication in Cases for Which No Other Form Is Applicable (FORM PCT/RO/132) was mailed from the U.S. Receiving Office (RO/US) to applicant. The Communication refused to add Li-Qun Wu and Mark J. Kastantin as inventors because the request was made to the RO/US on 22 February 2005, one day prior to the expiration of the 30 month period and thus, the Office was unable to transmit such request to the International Bureau in due time for recording under PCT Rule 92*bis*. A copy of said communication is enclosed.

The declaration submitted on 16 May 2006 erroneously identifies Li-Qun Wu and Mark J. Kastantin as co-inventors and thus is not in compliance with 37 CFR 1.497(a) and (b). Since Li-Qun Wu and Mark J. Kastantin were not accepted under PCT Rule 92*bis* as co-inventors, it is improper to accept the declaration identifying them as co-inventors. Applicant may wish to consider filing a petition under 37 CFR 1.497(d) to add Li-Qun Wu and Mark J. Kastantin as inventors.

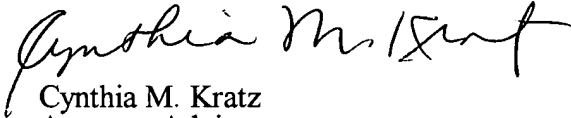
Furthermore, even if Li-Qun Wu and Mark J. Kastantin were properly added as inventors, the declaration as submitted is not in compliance with 37 CFR 1.497(a) and (b). The declaration is comprised of three pages, containing one page 1 and three duplicate page 2 signature pages and three duplicate page 3 signature pages. Each page 2 and page 3 is executed by a different inventor. It appears to be a composite declaration created from the combination of separately executed declarations. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. “Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration.” See MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed.

CONCLUSION

The declaration executed by Li-Qun Wu and Mark J. Kastantin as a joint inventors in the above referenced application is unacceptable and not in compliance with 37 CFR 1.497(a) and (b). A new declaration, in compliance with 37 CFR 1.497(a) and (b), and executed by the inventors as listed in the published international application, is required.

The application is now ABANDONED for failure to provide a proper reply to the Notification of Missing Requirements within the time period set forth in the Notification.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in cursive script, appearing to read "Cynthia M. Kratz".

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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Enclosure: FORM PCT/RO/132

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

To:

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COMMUNICATION IN CASES FOR WHICH
NO OTHER FORM IS APPLICABLE

Applicant's or agent's file reference <p style="text-align: center;">7512.145</p>	Date of mailing <i>(day/month/year)</i> <p style="text-align: center;">02 Jun 2006</p>
International application No. <p style="text-align: center;">PCT/US03/26356</p>	International filing date <i>(day/month/year)</i> <p style="text-align: center;">22 Aug 2003</p>
Applicant UNIVERSITY OF MARYLAND BIOTECHNOLOGY INSTITUTE	

1. ☐ REPLY DUE within _____ months/ days from the above date of mailing
- ☐ NO REPLY DUE, however, see below _____
- ☒ IMPORTANT COMMUNICATION
- ☐ INFORMATION ONLY

2. COMMUNICATION:

This is in response to applicants' "REQUEST TO CORRECT INVENTORSHIP UNDER RULE 92bis" filed 22 February 2005 and 16 May 2006 to add two more inventors, Le-Qun Wu and Mark J. Kastantin, to the present application. Applicants' request is REFUSED because under PCT Rule 92bis.1(b) "The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date." In the present case, the request was made to the RO/US one day prior to the expiration of the 30 months mentioned above, and therefore, this Office was unable to transmit such request to the International Bureau in due time for recording under PCT Rule 92bis.

Name and mailing address of the receiving Office Mail Stop PCT, Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450 Facsimile No. 703-305-3230	Authorized officer Ngoc-Ho Nguyen Telephone No. 571-272-3290
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